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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,533	06/26/2003	James M. Rhodes	DEP5054	5756

27777 7590 06/27/2007
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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/606,533	RHODES ET AL.	
	Examiner	Art Unit	
	Jeffrey G. Hoekstra	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 8,10,11,13,18,20 and 25-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7,9,12,14-17,19 and 21-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20070622</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination

1. Applicant's arguments, see Appeal Brief, filed 12/13/2006, with respect to claims 1-7, 9, 11-19, and 21-24 have been fully considered and are persuasive. The final rejections of claims 1-7, 9, 11-19, and 21-24 as set forth in the Final Office Action mailed 08/10/2006 are *withdrawn*. *Prosecution is reopened* and the following new grounds of rejection are set forth:

Previous Election/Restrictions

2. **TO CLARIFY THE RECORD,**

3. *The Examiner notes the following was set forth in the Requirement for Restriction/Election mailed 12/19/2005:*

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species I, claims drawn to Figure 1;
- Species II, claims drawn to Figure 8;
- Species III, claims drawn to Figure 19;
- Species IV, claims drawn to Figure 20;
- Species V, claims drawn to Figure 25;
- Species VI, claims drawn to Figure 27;
- Species VII, claims drawn to Figure 28; and
- Species VIII, claims drawn to Figure 29.

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5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

6. *The Examiner notes the following was set forth in the Non-Final Office Action mailed 02/14/2006:*

7. Applicant's election without traverse of Species IV, claims drawn to Fig. 20 in the reply filed on January 11, 2006 is acknowledged.

8. Claims 8, 10, 20, and 25-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 11, 2006.

9. **TO CORRECT THE RECORD,**

10. *The Examiner sets forth the following:*

11. The Examiner notes the previous Election/Restriction Requirement was incomplete and as such should have read as follows:

12. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species I: embodiment drawn to Figures 1-7 and 9-12,
- Species II: embodiment drawn to Figures 8, 13, and 15,
- Species III: embodiment drawn to Figure 19,
- Species IV: embodiment drawn to Figures 20-24,
- Species V: embodiment drawn to Figure 25,

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- Species VI: embodiment drawn to Figure 27,
- Species VII: embodiment drawn to Figure 28,
- Species VIII: embodiment drawn to Figure 29,
- Species IX: embodiment drawn to Figures 16-18, and
- Species X: embodiment drawn to Figure 26.

13. The species are independent or distinct because they are substantially dissimilar and structurally divergent means for configuring a surgical instrument.

14. Applicant's election without traverse of Species IV, embodiment drawn to Figures 20-24 in the reply filed on January 11, 2006 is acknowledged.

15. Claims 8, 10, 11, 13, 18, 20, and 25-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 11, 2006.

Election/Restrictions

16. The Examiner notes that because the previous Election/Restriction Requirement was incomplete the following new grounds of Election is set forth in the interest of clearly defining Applicant's invention:

17. This application contains claims directed to the following patentably distinct species:

- Species A: embodiment drawn to an "integral" surgical instrument and claims 1, 2, and 22-24 and

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- Species B: embodiment drawn to a “modular” surgical instrument and claims 3-7, 9, 11-15, and 16-21.

18. The species are independent or distinct because they are substantially dissimilar and structurally divergent means for configuring a surgical instrument.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

19. A telephone call was made to Steve Manich on 06/22/2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

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requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra
Examiner, Art Unit 3736

JH
6/22/07



MAX HINDENBURG
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